

REMARKS/ARGUMENTS

This Amendment and Response is promptly filed to place the above-referenced case in condition for immediate allowance.

The status of the claims is as follows:

Cancelled: 7 – 11, 13 – 14, 17 – 18, and 20 – 22;

Amended: 1, 3, 4, 6, 12, 15, and 16;

Added: None; and

Currently outstanding: 1 – 6, 12, 15, 16, and 19.

No new matter has been added to the application.

From the outstanding Office action, claims 1-6, 12, 13, 15-17, and 19 were rejected under 35 U.S.C. § 102(b) as being anticipated by the Segers '053 patent. Claims 14, 18, and 22, were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Segers '053 patent in view of the Adamec '010 patent.

The present reply has amended some claims and canceled others, the amendments generally directed to emphasizing the use of degermed corn in applicant's invention. These amendments generally reflect applicant's technology and no narrowing amendment to conform with statute has been made in the application by the amendments to the claims.

Reconsideration is respectfully requested.

As set forth in more detail below, neither the Segers patent or the Adamec patent indicate the use of degermed corn. Particularly, the Segers patent mentions nothing more than the use of whole cherry pits while the Adamec patent emphasizes the use of cracked corn. Neither of these approaches disclose that which is set forth in Applicant's specifications and is

set forth in his claims. Consequently, allowance of the claims as amended is believed to be appropriate at this time.

The Examiner rejected claims 1-6, 12, 13, 15-17, and 19 under 35 U.S.C. § 102(b) as being anticipated by the Segers '053 patent. From the above listing of claims, all claims now require degermed corn. No degermed corn is disclosed in the Segers '053 patent which relies solely on whole cherry pits. Consequently, the Segers patent cannot anticipate any of the claims, including those rejected by the Examiner.

Claims 14, 18, and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Segers '053 patent in view of the Adamec '010 patent. Applicant believes that these patents cannot be combined in order to reject the claims as amended as neither reference teaches the use of degermed corn nor teaches the advantages of segmented and/or degermed grains and seeds against resisting mold, fungus, and decay. Further, the references should not be combined as they teach away from one another.

As set forth in the Segers '053 patent, only whole cherry pits are used and these whole pits are separated from the broken and partial pieces (Segers, column 4, lines 20-35). No mention is made in Segers of any other filler than cherry pits. However, in the Adamec '010 patent, only grain seeds or sand are used and no mention of segmentation is set forth nor is degermed corn disclosed. Furthermore, there is no showing that the fillers used in Adamec can be substituted for the stones or pits used in Segers. Although there is mention of cracked corn in Adamec, there is no mention of the separation of those parts of the grain that are segmented and excluded from applicant's invention as set forth in his specification and claims. No mention is made of the removable bran coat and the germ. It is only when the applicant's

disclosure is used to complement the Adamec patent that any segmentation or degeneration is considered to present. There is no teaching in the Adamec '010 patent regarding the avoidance of rot, mold, and/or mildew that arises when the organic filler is not segmented.

Segers does not describe a segmented or organic filler in the form of any sort of degerned grain. Reference number 25 in the Segers patent refers only to cherry pits and as described above, cherry pits that have been in no way segmented or otherwise broken into pieces with the appropriate elements removed.

As no organic filler or degerned corn is present in either the Segers or Adamec patents that has been segmented to avoid rot, mold, mildew, etc., and as there is no motivation to combine these two patents, applicant believes that the outstanding claims are all patentable over the Segers and Adamec patents taken either separately or together in any reasonable combination.

From the foregoing, it can be seen that Applicant believes that there are a plurality of grounds upon which the rejections to the claims are overcome. Applicant also believes that, for similar reasons, there is no teaching or motivation to combine Segers with Adamec. In the recent past, the Court of Appeals for the Federal Circuit has spoken on this matter.

The Court of Appeals for the Federal Circuit (CAFC) has ruled that it is improper to reconstruct an applicant's invention on the basis of the applicant's total disclosure. In the present case, there is no disclosure or suggestion in any of the references relied on by the Examiner from which the decay-resistant thermal device claimed by Applicant may be constructed. Indeed, even in light of Applicant's own teaching, the Examiner has been unable

to reconstruct from the cited references a decay-resistance thermal device which meets the language of the present claims.

The Examiner cannot, in the absence of some suggestion or teaching in the references, simply combine references in an attempt to show that an applicant's claims are obvious. Ex parte Hiyamizu, 10 U.S.P.Q.2d 1393, 1394 (Pat. and Trademark Off. Bd. of Pat. App. and Interferences 1988). The CAFC has indicated that two questions are to be asked when a combination of references is relied upon to reject a claim:

- (1) whether a combination of the teachings of the references would have suggested (expressly or by implication) the possibility of achieving further improvement along the lines of the claimed invention; and
- (2) whether the claimed invention has achieved more than a combination which any or all of the prior art references suggested.

In re Sernaker, 702 F.2d 989, 217 U.S.P.Q. 1, 5 (Fed. Cir. 1983).

The Court emphasized that prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining these teachings. Something more than merely finding each element of the combination in the references is required, and here the Examiner has not even found that.

Applicant submits the Examiner has failed to demonstrate that the answer to either question should be decided against Applicant. None of the references, alone or in

combination, disclose or suggest the combination of elements recited in Applicant's present claims. As such, Applicant's claims all go beyond that which has been achieved before and are not reflected by any reasonable combination of the prior art references.

Further, the Examiner has pointed to nothing in any of the references that suggests combining their teachings. A reading of each of the references uncovers no suggestion or teaching in any of them as to the advantages to be gained by having segmented grain having decay-susceptible elements removed as only whole grains and seeds are disclosed. The Examiner has unsuccessfully tried to pull from the cited references specific elements claimed by Applicant, based on Applicant's own teaching and not on those teachings set forth in the cited references.

Finally, the subject matter of the invention as a whole must be considered. Even though features may be disclosed in the prior art, performing their ordained and expected function, the test is whether the claimed invention as a whole, in light of all of the teaching of the references in their entireties, would have been obvious to one of ordinary skill in the art. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983). Thus, it is clear that, in light of decisions of the CAFC, the Examiner has not met the CAFC's tests in combining references.

A reference is only good for what it clearly and definitely discloses. In re Moreton, 288 F.2d 708, 129 U.S.P.Q. 227, 230 (C.C.P.A. 1961); In re Hughes, 345 F.2d 184, 145 U.S.P.Q. 467, 471 (C.C.P.A. 1965). Furthermore, a patent is not a fair reference where it is not directed to the same purpose and does not involve the same inventive concept. Ex parte Garvey, 41 U.S.P.Q. 583 (Pat. and Trademark Off. Bd. of Pat. App. and Interferences 1939).

Absent a clear disclosure, i.e., an anticipation or some other special statutory prohibition, a rejection must stand or fall on the existence of obviousness as qualified in 35 U.S.C. § 103. In re Murray et al., 268 F.2d 226, 122 U.S.P.Q. 364, 367 (C.C.P.A. 1959).

It is submitted that the claims under discussion are not anticipated or obvious in view of the references made of record and the references relied upon by the Examiner in the rejections. The claims patently define over each of the references, either individually or taken in any reasonable combination.

A combination of references is improperly applied where there is no suggestion by any of the references of the problem involved or where the solution to the problem is neither indicated nor taught. In re Shaffer, 229 F.2d 476, 108 U.S.P.Q. 326, 329 (C.C.P.A. 1956). When references are combined, it should be considered whether the references suggest a thing which the applicant has done. In re Gruskin, 234 F.2d 493, 110 U.S.P.Q. 288, 292 (C.C.P.A. 1956). Moreover, references may not be combined where there is no suggestion in either of the references that they can be combined to meet the recitation of the applicant's claims. In re Hortman, 264 F.2d 911, 121 U.S.P.Q. 218, 220 (C.C.P.A. 1959); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984); see also Ex parte Hiyamizu, 10 U.S.P.Q.2d 1393, 1394 (Pat. and Trademark Off. Bd. of Pat. App. and Interferences 1988).

Whether a combination of references negates patentability depends solely upon what the references would reasonably and realistically teach those of ordinary skill in the art. In re Free, 329 F.2d 998, 141 U.S.P.Q. 238, 240 (C.C.P.A. 1964); In re Sernaker, 702 F.2d 989, 217 U.S.P.Q. 1, 5 (Fed. Cir. 1983). What the Examiner is attempting is a piecemeal

construction of the prior art in view of the Applicant's own disclosure in order to negate the present invention. The law clearly does not sanction this procedure. In re Rothermel et al., 276 F.2d 393, 125 U.S.P.Q. 328, 331 (C.C.P.A. 1960); In re Kamm & Young, 452 F.2d 1052, 172 U.S.P.Q. 298, 301 (C.C.P.A. 1972); W. L. Gore & Assoc. v. Garlock, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

As the CAFC has stated in Environmental Designs, Ltd. et al. v. Union Oil of Cal. et al.;

"Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art

...."

713 F.2d 693, 218 U.S.P.Q. 865, 870 (Fed. Cir. 1983), cert. denied, 104 S. Ct. 709, 224 U.S.P.Q. 520 (1984).

The CAFC has ruled that it is improper to reconstruct an applicant's invention on the basis of the applicant's total disclosure. There is no teaching or suggestion in either the Segers and Adamec references relied on by the Examiner from which the invention claimed by Applicant can be constructed as segmented and/or degерmed grains are generally absent from these references. No mention of segmentation is present either in Segers or Adamec. In In re Newell, 891 F.2d 899, 13 U.S.P.Q.2d 1248, 1250 (Fed. Cir. 1989) the Federal Circuit Court stated:

.... a retrospective view of inherency is not a substitute for some teaching or suggestion [in prior art] which supports

selection and use of the various elements in particular claimed combination. . . . It is well established that in deciding that a novel combination would have been obvious, there must be supporting teaching in the prior art.

See also, accord, In re Laskowski, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

From the foregoing remarks, Applicant's claims is believed to be patentable over Segers in view of Adamec.

In view of the above, the Examiner is respectfully requested to reconsider his position in view of the remarks made herein and the structural distinctions now set forth. The Examiner's rejections of the outstanding claims are believed to no longer apply. It is now believed that this application has been placed in condition for allowance, and such action is respectfully requested. Prompt and favorable action on the merits is earnestly solicited. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

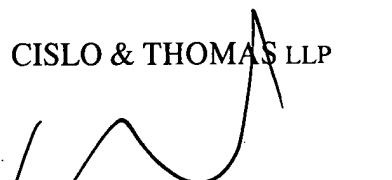
The statements made herein with respect to the disclosures in the cited references represent the present opinions of the undersigned attorney. In the event that the Examiner disagrees with any of such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the respective references providing the basis for a contrary view.

If the Examiner believes that a telephone or other conference would be of value in expediting the prosecution of the present application, enabling an Examiner's amendment or other meaningful discussion of the case, Applicant invites the Examiner to contact Applicant's representative at the number listed below.

With the above-referenced changes, it is believed that the application is in a condition for allowance; and Applicant respectfully requests the Examiner to pass the application on to allowance. It is not believed that any additional fees are due; however, in the event any additional fees are due, the Examiner is authorized to charge Applicant's Attorney's Deposit Account No. 03-2030.

Respectfully submitted,

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Date: January 20, 2006

DMC/ASJ/at

Enclosures

Petition for Extension of Time - 1 Month
Acknowledgement Postcard

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Date